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TRANSMITTAL FORM <i>(to be used for all correspondence during pendency of filed application)</i>	Application Number	09/193,833	
	Filing Date	November 17, 1998	
	First Named Inventor	Mark Gainey, et al.	
	Group Art Unit Number	2177	
	Examiner Name	Debbie Le	
Total Number of Pages in This Submission	15	Attorney Docket Number	20115-06977

ENCLOSURES (check all that apply)	
<input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate) <input checked="" type="checkbox"/> Deposit account authorization <input checked="" type="checkbox"/> Return Receipt Postcard <input type="checkbox"/> Response to Notice to File Missing Parts <input type="checkbox"/> Assignment & Recordation Cover Sheet <input type="checkbox"/> Declaration <input type="checkbox"/> Power of Attorney <input type="checkbox"/> Application Data Sheet <input type="checkbox"/> Information Disclosure Statement & PTO/SB/08A <input type="checkbox"/> Copies of IDS Cited References <input type="checkbox"/> Request for Corrected Filing Receipt <input type="checkbox"/> Request for Correction of Recorded Assignment <input type="checkbox"/> Amendment/Response: [] Page(s) <input type="checkbox"/> After Final <input type="checkbox"/> Status Request <input type="checkbox"/> Revocation and Substitute Power of Attorney	<input type="checkbox"/> Issue Fee Transmittal <input type="checkbox"/> Letter to Chief Draftsperson <input type="checkbox"/> Formal Drawing(s): [] Sheet(s) of Figure(s) [] <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Brief <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>
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Attorney/Reg. No.:	Daniel R. Brownstone, 46,581	Dated:	December 17, 2004

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20115/06977/SF/5120857.1

DEC 21 2004

FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** 1330**Complete if Known**

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Filing Date	November 17, 1998
First Named Inventor	Mark Gainey, et al.
Examiner Name	Debbie M. Le
Art Unit	2177
Attorney Docket No.	20115-06977

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

Deposit Account Number

19-2555

Deposit Account Name

Fenwick & West LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge all required fee(s) or any underpayment of fee(s) due under 37 CFR §1.16 or §1.17 during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath or declaration	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	1,080
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	250
1403	1000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1100	2503	550	Plant issue fee	
1460		1460		Petitions to the Director	
1807	50	1807	50	Processing fee for Provisional Applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

SUBTOTAL (1) (\$)**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	=
Multiple Dependent	-3** =	X	=

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1202	50	2202	25	Claims in excess of 20
1201	200	2201	100	Independent claims in excess of 3
1203	360	2203	180	Multiple dependent claim, if not paid
1204	200	2204	100	**Reissue independent claims over original patent
1205	50	2205	25	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath or declaration	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
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1254	1,590	2254	795	Extension for reply within fourth month	
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1403	1000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
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1807	50	1807	50	Processing fee for Provisional Applications	
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1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

SUBTOTAL (3) (\$)

*Reduced by Basic Filing Fee Paid

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Date

December 17, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Mark Gainey, Alex Broquet, and Michael Horvath
SERIAL NO.: 09/193,833
FILING DATE: November 17, 1998
TITLE: Method and Apparatus For Performing Enterprise Email Management
EXAMINER: Debbie M. Le
GROUP ART UNIT: 2177
ATTY. DKT. NO.: 20115-06977

CERTIFICATE OF MAILING

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APPEAL BRIEF

Real Party in Interest

The real party in interest in this Appeal is Kana Software, Inc., a Delaware corporation.

Related Appeals and Interferences

No other prior or pending appeals, interferences or judicial proceedings are known to Appellant, Appellant's legal representative, or the Assignee that may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 4-13 and 17-21 are pending in this Application and stand rejected. Claims 1-3 and 14-16 have been canceled. Claims 4-13 and 17-21 are included in this Appeal.

Status of Amendments

A final rejection was mailed by the Examiner on November 13, 2003. No amendment has been filed by Applicants subsequent to the final rejection.

Summary of Claimed Subject Matter

Claim 4 recites a computer-implemented method for processing electronic messages. When a message is received at an enterprise mail system (100), it is stored in a database (130) (p. 10, lines 21-26) and assigned a category entry selected from a category database (135) (p. 14, line 29 - p. 15, line 15). The category entry has information that describes how to handle incoming messages of that category type. The message is then delivered to a user of the enterprise mail system, along with a template response (p. 18, line 7 - p. 19, line 4). The particular template response used is determined according to the information in the category entry associated with the incoming message (p. 5, lines 1-8; p. 18, lines 1-5). The category entry also specifies a set of recipients for the template message, and those recipients are included in the template message provided to the user of the enterprise mail system (p. 16, line 19 - p. 17, line 8). One advantage of the invention of claim 4 is that generated template responses include a set of predefined message recipients according to the assigned category entry. This means that responses of one type (e.g., presales inquiries) can have a first set of message recipients, while responses of another type (e.g., invoice disputes) can have a second set of message recipients.

Claim 17 recites a method for processing electronic messages in which an electronic mail message is received and its contents are analyzed. The message is then associated with a message category responsive to the analysis of the message contents (p. 14, line 29 – p. 16, line 13). Next, a skeleton response message is generated automatically and addressed to at least one recipient. The recipients are selected based on the association between the message and the category (p. 18, lines 1-5). The method of claim 17 provides for the analysis of incoming messages, and for their assignment to an appropriate category. Once assigned to a category, a response message is automatically generated and addressed to a category-specific list of recipients. One of the benefits of the claimed invention is that category-specific recipients can be predefined, thus improving efficiency for the CSRs and insuring that the most appropriate people within an enterprise see each message.

Claim 20 recites an electronic mail processing system, and includes four means-plus-function elements as permitted by 35 U.S.C. § 112, sixth paragraph. Claim 20 includes receiving means (incoming e-mail receiver 120) for receiving an electronic message (p. 8, lines 26-28); analyzing means (a rule processor of the incoming e-mail receiver 120) for analyzing the contents of the received electronic mail message (p. 11, line 11 – p. 13, line 3); associating means (incoming e-mail receiver 120) for associating the electronic mail message with a message category responsive to the analysis of the contents of the message (p. 14, line 29 – p. 16, line 14); and generating means (incoming e-mail processor 120) for automatically generating a skeleton response message to at least one recipient, wherein the recipients are selected responsive to associating the electronic mail message with the message category (p. 28, lines 12-13).

Finally, claim 21 recites a computer program product, similar to claim 17. The computer program product includes instructions for executing the step of

receiving an electronic mail message. The message is then associated with a message category responsive to the analysis of the message contents (p. 14, line 29 – p. 16, line 13). Next, a skeleton response message is generated automatically and addressed to at least one recipient. The recipients are selected based on the association between the message and the category (p. 18, lines 1-5).

Grounds of Rejection to be Reviewed on Appeal

Claims 4, 6-7, and 12-13 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,122,632 to Botts et al. (“Botts”).

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Botts in view of U.S. Patent No. 6,226,630 to Billmers et al. (“Billmers201D”).

Claims 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Botts in view of U.S. Patent No. 5,806,057 to Gormley et al. (“Gormley”).

Claims 17-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Billmers in view of U.S. Patent No. 6,182,059 to Angotti.

Argument

Rejections Under 35 U.S.C. § 102(e)

Claims 4, 6-7, 12-13

The Examiner rejected claims 4, 6-7 and 12-13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,122,632 to Botts. To anticipate a claim under § 102(e), a prior art reference must describe each and every element as set forth in the claim, either expressly or inherently. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Verdegad Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also* MPEP § 2131. The rejection was improper because Botts does not describe all of the limitations of the rejected claims.

Botts discloses an e-mail management system in which incoming e-mails are recorded in a database and provided to customer service representatives (CSRs) for response. While Botts describes assigning a category to a message and indexing and retrieving standard responses according to a particular category, Botts does not describe generating a template response "including a set of message recipients defined in said category entry." There is no correlation in Botts between a particular category of a message and the recipients of a response message.

In response to Applicants' assertion that Botts does not disclose generating a template response including a set of message recipients defined in a category entry, the Examiner responded that "E-mail messages are preferably grouped according to the e-mail addresses where in the inquiry was sent, col. 8, lines 35-36, by selecting a group, the corresponding electronic messages received, and queued, for that group are retrieved, col. 8, lines 48-49)" (Office Action of Nov. 13, 2003, p. 7). However, the Examiner is confusing inbound messages waiting for review by customer service representatives with template responses including category-defined message recipients. For example, at the first location cited by the Examiner, col. 8, lines 35-36, Botts actually describes that received e-mail messages are preferably grouped for storage purposes according to the e-mail addresses to which they were directed. The sentence immediately following the one identified by the Examiner is instructive: "For example, all e-mail messages sent to a particular e-mail group are all preferably grouped together, stored together in the database 16, and accessed together" (col. 8, lines 36-39). This feature of Botts is unrelated to a response to e-mails that have been received, including the claimed step of addressing a response according to recipients specified in a category entry associated with the incoming message. Likewise, the passage cited by the Examiner at col. 48-49 discloses that a

customer service representative selects a group of e-mail messages to respond to, and that by selecting a group, the e-mail messages in the group are received and queued from the database and sent to the CSR's computer.

In none of the passages cited by the Examiner, and indeed nowhere in Botts, is the claimed step of "providing a template response message to said first enterprise mail system user using information in said category entry, said template response message including a set of message recipients defined in said category entry" disclosed. Accordingly, claim 4 is not anticipated by Botts and the rejection should be reversed. Claims 6-7 and 12-13 were also rejected over Botts and are patentable for at least the same reasons as claim 4, in addition to reciting their own patentable features. Similarly, claim 5 – rejected under 35 U.S.C. § 103(a) and therefore described in the next section – also depends from claim 1, and is therefore also patentable.

Rejections Under 35 U.S.C. § 103(a)

Claim 5

The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Botts in view of U.S. Patent No. 6,226,630 to Billmers et al. (Billmers). Claim 5 recites that the assigning a category entry step of claim 4 is performed by a rule processor.

Billmers does not teach the claimed invention. Billmers discloses a system for filtering e-mails. When an e-mail is received by a filter in Billmers, an index extracted from the contents of the message is created and stored in an index database (see col. 4, lines 8-12). Billmers does not disclose a rule processor, nor does Billmers disclose assigning category entries from a category database to messages. Even if Billmers did disclose such steps, nothing in Billmers teaches or suggests the step missing from Botts of "providing a template response message

to said first enterprise mail system user using information in said category entry, said template response message including a set of message recipients defined in said category entry.” Accordingly, neither reference alone or in combination teaches the invention of claim 5, and the rejection of claim 5 should be reversed.

Claims 8-11

The Examiner rejected claims 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Botts in view of U.S. Patent No. 5,806,057 to Gormley et al. (“Gormley”). Gormley describes a system for managing a database storing records used for processing queries and performing telemarketing, mass mailing, direct mailing and other communication functions. However, because Gormley does not recite the element of “providing a template response message to said first enterprise mail system user using information in said category entry, said template response message including a set of message recipients defined in said category entry,” it does not cure the defects of Botts. Accordingly, the combination of Gormley and Botts does not render obvious claims 8-11, and the rejection of those claims should be reversed.

Claims 17-21

The Examiner rejected claims 17-21 under 35 U.S.C. § 103(a) as being unpatentable over Billmers in view of U.S. Patent No. 6,182,059 to Angotti.

Billmers does not teach the claimed invention. Billmers discloses a system for filtering e-mails. When an e-mail is received by a filter in Billmers, an index extracted from the contents of the message is created and stored in an index database (see col. 4, lines 8-12). Indeed, the portions of Billmers cited by the Examiner at col. 4, lines 8-25 and col. 7, lines 9-24 respectively teach building an index from extracted text, and using a rule processor to perform storing and

alerting actions on incoming messages. As the Examiner admits, Billmers does not disclose "automatically generating a skeleton response message to at least one recipient, wherein the recipients are selected responsive to associating the electronic mail message with the message category."

The addition of Angotti does not cure the defects of Billmers. Angotti is directed to automatically interpreting a received e-mail and determining whether it can be responded to automatically. However, Angotti does not disclose the steps of the claimed invention. For example, Angotti does not disclose "automatically generating a skeleton response message to at least one recipient, wherein the recipients are selected responsive to associating the electronic mail message with the message category." Indeed, nothing in Angotti suggests or describes using message categories to define a set of message recipients to receive the response. Accordingly, claim 17 is patentable over both Billmers and Angotti, both alone and in combination with one another, and the rejection of claim 17 should be reversed. The rejection of claims 18-21 should also be reversed, both because claims 18-21 depend from patentable claim 17 and because each recites its own patentable features.

In view of the above Arguments, the Examiner's rejections of claims 4-13 and 17-21 were erroneous, and Applicants respectfully request that the Board reverse.

Respectfully submitted,
Mark Gainey, Alex Broquet,
and Michael Horvath

Date: 12/17/04

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Claims Appendix

1 1. – 3. (Cancelled)

1 4. A computer implemented method for processing electronic messages, said
2 method comprising:
3 receiving a first message into an enterprise mail system, said first message from a
4 first human message sender;
5 storing said first message in a message database;
6 assigning a category entry from a category database to said first message, said
7 category entry containing information for handling particular incoming
8 messages;
9 delivering said first message to a first enterprise mail system user; and
10 providing a template response message to said first enterprise mail system user
11 using information in said category entry, said template response message
12 including a set of message recipients defined in said category entry.

1 5. The method of claim 4 wherein assigning a category entry from a category
2 database to said first message is performed by a rule processor.

1 6. The method of claim 4 wherein assigning a category entry from a category
2 database to said first message is performed by said first enterprise and system user.

1 7. The method of claim 4 wherein providing a template response message
2 further comprises:
3 providing a set of default message body sections for said template response
4 message.

1 8. The method of claim 7 wherein one of said set of default message body
2 sections comprises a salutation.

1 9. The method of claim 7 wherein one of said set of default message body
2 sections comprises a body header.

1 10. The method of claim 7 wherein one of said set of default message body
2 sections comprises a closing.

1 11. The method of claim 7 wherein one of said set of default message body
2 sections comprises a footer.

1 12. The method of claim 4 wherein said message database comprises a relational
2 database.

1 13. The method of claim 4 wherein one of said set of message recipients
2 comprises said human message sender.

1 14. – 16. (Cancelled)

1 17. A method for processing electronic mail messages, the method comprising:
2 receiving an electronic mail message;
3 analyzing the contents of the received electronic mail message;
4 responsive to the analysis of the contents of the message, associating the
5 electronic mail message with a message category; and
6 automatically generating a skeleton response message to at least one recipient,
7 wherein the recipients are selected responsive to associating the electronic
8 mail message with the message category.

1 18. The method of claim 17 wherein the analysis of the contents of the received
2 electronic mail message is performed automatically.

1 19. The method of claim 17 wherein the analysis of the contents of the received
2 electronic mail message is performed manually.

1 20. An electronic mail processing system comprising:
2 receiving means for receiving an electronic mail message;
3 analyzing means, coupled to the receiving means, for analyzing the contents of
4 the received electronic mail message;
5 associating means, coupled to the analyzing means, for associating the electronic
6 mail message with a message category responsive to the analysis of the
7 contents of the message; and
8 generating means, coupled to the analyzing means, automatically generating a
9 skeleton response message to at least one recipient, wherein the recipients are
10 selected responsive to associating the electronic mail message with the
11 message category.

1 21. A computer program product stored on a computer readable medium and
2 containing instructions to control a computer processor to execute the steps of:
3 receiving an electronic mail message;
4 analyzing the contents of the received electronic mail message;
5 responsive to the analysis of the contents of the message, associating the
6 electronic mail message with a message category; and
7 automatically generating a skeleton response message to at least one recipient,
8 wherein the recipients are selected responsive to associating the electronic
9 mail message with the message category.